<u>**REMARKS/ARGUMENTS**</u>

Claims 1-21 are pending in the present application. Claims 1, 5, 9, 13, 15 and 19 have been amended herewith. Reconsideration of the claims is respectfully requested.

I.   35 U.S.C. § 101

Claims 9-20 stand rejected under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed.

In rejecting Claims 9-20, the Examiner alleges such claims are merely directed to a programmed functionality of a system or a computer program product, and not to a process, machine, manufacture or composition of matter.

As to Claim 9 (and dependent Claims 10-14), Applicant has amended such claim to specifically recite machine structure (a 'video display') of the data processing system in the body of the claim, as per the Specification description at page 7, 1st full paragraph and as depicted in Figure 1, element 104.

As to Claim 15, such claim complies with both the USPTO guidelines and judicial case law regarding proper statutory subject matter under 35 U.S.C. § 101. Specifically, Claim 15 recites "A computer program product encoded in a computer readable, recordable-type medium and operable in a data processing system for managing display of a new document". Applicant urges that a claimed computer program product encoded in a computer readable, recordable-type medium and operable in a data processing system for managing display of a new document is a computer element which defines structural and functional inter-relationships between the computer program and the rest of the computer which permits the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.[1] Claim 15 was previously amended to specifically comply with the allowable form of a computer readable media claim as provided by *Lowry*, and thus Claim 15 (and similarly for Claims 16-20) is statutory under 35 U.S.C. § 101.

Still further, Claim 15 explicitly recites a computer program product encoded in a computer readable, recordable-type medium and operable in a data processing system for managing display of a

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[1] The USPTO's own guidelines similarly state this type of claim is proper under 35 U.S.C. § 101. For example, as stated in the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (published in the Official Gazette on November 22, 2005) at ANNEX IV (Computer-Related Nonstatutory Subject Matter) "When functional descriptive material is recorded on some **computer-readable medium** it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory)."

new document, which is either a 'manufacture' or a 'composition of matter', both of which are statutorily recognized subject matter[2]. In addition, since Claim 15 explicitly recites a computer program product encoded in a computer readable, recordable-type medium and operable in a data processing system for managing display of a new document, such claim does *not* fall within one of the three judicially determined exceptions of: natural phenomenon, law of nature or abstract idea (see, e.g., MPEP 2106 and in particular MPEP 2106(IV)(B) and (C)), but instead is limited to a practical application in the technological arts[3]. Thus, it is further shown that Claim 15 (and dependent Claims 16-20) has been erroneously rejected under 35 U.S.C. § 101 as the invention recited therein does not fall within a judicial exception but instead is limited to a practical application in the technological arts.

Therefore, the rejection of Claims 9-20 under 35 U.S.C. § 101 has been overcome.

II.   35 U.S.C. § 102, Anticipation

Claims 1-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Sylor et al. (U.S. Publication No. 2002/0186238), hereinafter "Sylor". This rejection is respectfully traversed.

For a prior art reference to anticipate in terms of 35 U.S.C. 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Applicant will now show that every element recited in Claims 1-21 is not identically shown in the cited Sylor reference, and thus Claims 1-21 have been erroneously rejected under 35 U.S.C. § 102(e).

Claim 1 recites a step of "displaying, in response to receiving a user input indicating that the new document is to be displayed, a list of currently active browser windows including an indication of a presently displayed document in each respective browser window in the list of currently active browser windows". As can be seen, there is a 'displaying' step, and this displaying step occurs in response to a step of receiving a user input indicating that a *new document is to be displayed*. Further, Claim 1 states that *what* is displayed is (1) a list of currently active browser windows and (2) an indication of a presently displayed document in each respective browser window in the list of currently active browser windows. This can be seen in Applicant's preferred embodiment depicted in Figure 4B, element 426, where both (1) a list of currently active browser windows is displayed, *as well as* (2) an indication of a presently

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[2] **35 U.S.C. 101 Inventions patentable.**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

[3] *Only when* the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. § 101. Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971).

displayed document in each respective browser window in the list of currently active browser windows. This is substantially different from the teachings of the cited reference. The Examiner states that the display of these two categories of items is described by Sylor at paragraphs 0152 and 0177, and in particular noting the 'title bar' feature. Applicant urges error in such assertion. As Sylor describes at paragraphs 0152:

> "[0152] The "File" dropdown menu 518 includes dropdown items 519 for "New", "Open", "Delete", "Connect to server", "New window", "Recent list", and "Exit". "New" allows user 23 to select logical hierarchy 30 to open in a new display window 50, while "Open" allows the same selection but uses an existing display window 50. "Delete" allows the user to close such display window 50. "Connect to server" opens a login dialog (not shown) so that user 23 may present credentials to web server 60. "New window" opens a redundant version of the current display window 50. "Recent list" is a flexible list of several dropdown items 519, each dropdown item 519 corresponding to a recently used logical hierarchy 30. Menu separators 521 can bracket the "Recent list". "Exit" starts a process to close client application 22."

As can be seen, this paragraph describes various actions that are selectable from a File dropdown menu, including (1) New, (2) Open, (3) Delete, (4) Connect to Server, (5) New window, (6) Recent list and (7) Exit. Because Claim 1 recites that the displaying step occurs in response to a user indicating that a 'new' document is to be displayed, the relevant portion of the above cited passage would be the discussion pertaining to (1) New or (2) Open or (5) New window. This cited passage states that in response to a user indicating that a 'new' document is to be displayed, *the user 23 is allowed to select logical hierarchy 30 to open in a new or existing display window 50*. Selecting logical hierarchy 30 to open a new or existing display window 50 does not teach any displaying of both (1) a list of currently active browser windows, *as well as* (2) an indication of a presently displayed document in each respective browser window in the list of currently active browser windows. Instead, and as can be seen by Sylor's Figure 6B, a display window 50 is displayed. There is nothing shown/displayed in this display window 50 that indicates either (1) a list of currently active browser windows is displayed, or (2) an indication of a *presently displayed document in each respective browser window* in the list of currently active browser windows, both of which are explicitly recited in Claim 1. Instead, menus of *commands* are depicted by Sylor. Thus, this cited passage does not teach the displaying step recited in Claim 1, as this cited passage does not teach displaying of *both* (1) a list of currently active browser windows, *as well as* (2) an indication of a presently displayed document in each respective browser window in the list of currently active browser windows.

Nor does the Sylor cited passage at paragraph [0177] overcome this 'displaying' step teaching deficiency. There, Sylor states:

> "[0177] Main UI class 67 presents display window 50 that is the first interactive window presented by client application 22 at startup. When user 23 chooses dropdown item 519 (shown in FIG. 6B) such "New" or "Open" that opens logical hierarchy 30 for display, an instance of Main UI class 67 manages the displaying. As shown in FIG. 7B, Main UI class 67 launches objects including synch browser manager 68, viewer model 69, and viewer 64."

This passage states that in response to a user choosing a 'New' or "Open' command, a logical hierarchy 30 is open for display, and a synch browser manager, viewer model and viewer are launched. The 'opening of a logical hierarchy for display' does not teach the claimed step of displaying (1) a list of currently active browser windows and (2) an indication of a presently displayed document in each respective browser window in the list of currently active browser windows, as expressly recited in Claim 1. Instead, such opening of a logical hierarchy is described as being a flexible structure for collecting resource profiles and their relevant dependency relationships under one or more conceptual frameworks (Sylor paragraph [0084]).

Thus, as every element recited in Claim 1 is not identically shown in a single reference - and in particular there is no teaching of displaying, in response to receiving a user input indicating that the new document is to be displayed, a list of currently active browser windows including an indication of a presently displayed document in each respective browser window in the list of currently active browser windows- it is urged that Claim 1 is not anticipated by the cited reference.

Applicant initially traverses the rejection of Claims 2-8 for reasons given above with respect to Claim 1 (of which Claims 2-8 depend upon).

Further with respect to Claim 4, such claim recites "wherein the indication is a thumbnail of the document" (with the 'indication' being defined per Claim 1 to be 'an indication of a presently displayed document in *each* respective browser window in the list of currently active browser windows'). In rejecting Claim 4, the Examiner states that this claimed feature is taught by Sylor at paragraph [0102]. Applicant urges that there, Sylor states:

> "[0102] Title bar 511 contains text identifying client application 22 as the owner of display window 50 among the (possibly several) applications running on operating system 631 (shown in FIG. 1B). Title bar 511 provides other functions specific to operating system 631. Usually the functions include the ability to relocate, resize, request the close of, or restore the size of, display window 50."

As can be seen, this cited passage describes (1) <u>text</u> that identifies the client application that is the owner of the display (as there can be multiple applications running), and (2) an ability to manipulate the window by moving, sizing or closing the window. This is different from what is recited in Claim 4 for at least two reasons. First, this cited passage does not describe *any* type of indication of a presently displayed document *in <u>each</u> respective browser window <u>in the list of currently active browser windows</u>*. Secondly, this cited passage does not describe any *thumbnail* of a document, as expressly recited in Claim 4. Thus, Claim 4 has been erroneously rejected as there are at least two claimed features (as described above) that are not taught by either this cited passage or the cited reference as a whole.

Further with respect to Claim 5, such claim recites "wherein the list of currently active browser windows is displayed in a pop-up menu". As can be seen, the list of currently active browser windows (i.e. a list of multiple active browser windows) is displayed in a pop-up menu per the features of Claim 5. In rejecting Claim 5, the Examiner states that a pop-up window that displays a list of browser windows is taught by Sylor at paragraphs [0152] and [0177]. Applicant respectfully submits that the Sylor description at paragraph [0152] describes a *menu with commands* that can be selected for execution by a user. There is no *list of browser windows* in file menu 518 (see, e.g., Sylor Figure 6B), but instead is a list of *recently <u>used</u> logical hierarchies* (Sylor paragraph [0152]). As to the Sylor description at paragraph [0177], this passage describes this same file menu 518, and this cited passage also does not describe any type of list of browser windows. Thus, it is further urged that Claim 5 has been erroneously rejected as there are additional claimed features that are not identically shown in the cited Sylor reference.

Applicant initially traverses the rejection of Claims 9-21 for similar reasons to those given above with respect to Claim 1.

Applicant further traverses the rejection of Claims 12 and 18 for similar reasons to the further reasons given above with respect to Claim 4.

Applicant further traverses the rejection of Claims 13 and 19 for similar reasons to the further reasons given above with respect to Claim 5.

Therefore, the rejection of Claims 1-21 under 35 U.S.C. § 102(e) has been overcome.

III.   Conclusion

It is respectfully urged that the subject application is patentable over the cited reference and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

/Wayne P. Bailey/

Wayne P. Bailey
Reg. No. 34,289
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorney for Applicant